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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,442	08/13/2001	Gen Kanai	Q65835	4176

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EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,442

Applicant(s)

KANAI ET AL.

Examiner

Marc A Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,9,11,13,15,17,19,21,23,25,27,29,31,33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,11,13,15,17,19,21,23,25,27,29,31,33 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 second paragraph rejection of Claim 1, of record on page 2 of the previous Action, is withdrawn.

The 35 U.S.C. 102(b) rejection of Claims 1, 3 – 4, 9, 15, 23 and 31 as being anticipated by Kuroda et al (U.S. Patent No. 5,079,273), of record on page 3 of the previous Action, is withdrawn.

REPEATED REJECTIONS

2. The 35 U.S.C. 112 second paragraph rejection of Claims 11, 13, 17, 19, 21, 25, 27, and 29, of record on page 2 of the previous Action, is repeated.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 4, 9, 15, 23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda et al (U.S. Patent No. 5,079,273).

With regard to Claims 1 – 2, Kuroda et al disclose a resin composition for heat – shrinkable polypropylene shrink label (for a container; column 2, lines 4 – 13; column 4, lines 35

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– 44) which comprises 60% by weight crystalline polypropylene – olefin random copolymer mainly comprising polypropylene (column 3, lines 59 – 68; column 4, lines 1 – 13) and 40% by weight of an alicyclic hydrocarbon resin having a softening temperature of not lower than 110 degrees Celsius (hydrogenated cyclopentadiene; column 3, lines 59 – 68; column 4, lines 1 – 13); the copolymer exhibits a melt flow rate of 0.5 to 10 grams / 10 minutes at 230 degrees Celsius and a load of 2.16 kilograms (column 4, lines 3 – 13; column 12, lines 21 – 23) and a crystal melting point of 120 to 145 degrees Celsius (therefore a fusion peak temperature, and a temperature at which the amount of heat of fusion is 50% of between 120 to 145 degrees Celsius as determined by means of a differential scanning calorimeter; column 7, lines 26 – 41). Kuroda et al fail to disclose a composition having at least one peak of loss tangent measured at a frequency of 1 hertz and a strain of 0.1% in the range from 30 degrees Celsius to 100 degrees Celsius, and a peak value thereof not smaller than 0.10. However, as discussed above, Kuroda et al disclose a composition comprising an alicyclic component having a softening temperature of not lower than 110 degrees Celsius, and a 60% by weight crystalline polypropylene – olefin random copolymer mainly comprising polypropylene as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select an alicyclic component having a softening temperature of not lower than 110 degrees Celsius, but which is different from the alicyclic component disclosed by Kuroda et al, to provide a desired softening temperature of the composition and therefore peaks of loss tangent measured at a frequency of 1 hertz and a strain of 0.1% in the range from 30 degrees Celsius to 100 degrees Celsius, since it has been held to be within the general skill of a worker in the art to select a known material on

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the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

.With regard to Claim 3, the propylene – olefin copolymer is a propylene – ethylene random copolymer (column 2, lines 4 – 13; column 4, lines 35 – 44).

With regard to Claims 4, 9, 23 and 31, the scope of the claims falls within the limitations of Kuroda et al as discussed above. The method of making the copolymer (product – by – process) is given little patentable weight.

With regard to Claim 15, the composition comprises an antiblocking agent (slip agent; column 10, lines 12 – 20).

5. Claims 11, 13, 17, 19, 21, 25, 27, 29, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda et al (U.S. Patent No. 5,079,273).

Kuroda et al disclose a heat – shrinkable composition as discussed above, comprising a single layer (sheet; column 10, lines 44 – 49 and having a specific gravity of 0.85 grams per cubic centimeter (density; column 3, lines 49 – 58; column 12, lines 30 – 34). With regard to Claims 11, 13, 17, 19, 21, 25, 27, 29, 33 and 35, Kuroda et al fail to disclose a composition comprising at least two layers, and a composition comprising one layer which comprises 1 to 50% of the total film thickness and a composition having a shrinkage rate of less than 3% at 40 degrees Celsius in seven days, and a composition having a shrinkage rate proportional to specific gravity at 80 degrees, 90 degrees and 100 degrees Celsius for ten seconds. However, Kuroda et al disclose a composition having a shrinkage rate of 10% at 100 degrees Celsius (column 11, lines 57 – 63). Therefore, the number of layers (each therefore having at least a fraction of 1% of

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the total thickness) and the shrinkage rate would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the number of layers and the shrinkage rate, since the number of layers and the shrinkage rate would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Kuroda et al. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments regarding the 35 U.S.C. 112 second paragraph rejection of Claim 1, of record on page 2 of the previous Action, have been considered and have been found to be persuasive. The rejection is therefore withdrawn.

Applicant's arguments regarding the 35 U.S.C. 112 second paragraph rejection of Claims 11, 13, 17, 19, 21, 25, 27, and 29, 35 U.S.C. 102(b) rejection of Claims 1, 3 – 4, 9, 15, 23 and 31 as being anticipated by Kuroda et al (U.S. Patent No. 5,079,273), 35 U.S.C. 103(a) rejection of Claim 2 as being unpatentable over Kuroda et al (U.S. Patent No. 5,079,273) and 35 U.S.C. 103(a) rejection of Claims 11, 13, 17, 19, 21, 25, 27, 29, 33 and 35 as being unpatentable over Kuroda et al (U.S. Patent No. 5,079,273), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below. Applicant argues, on page 13 of Paper No. 11, that the language reciting 'a laminate film which comprises an interlayer (I) and a surface layer (II) is reasonably clear. However, the term

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'interlayer' has not been defined. The prefix 'inter' would appear to indicate a layer which bonds two other layers together, but only one other layer has been claimed.

Applicant also argues, on page 14, that the Kuroda et al does not present a peak at 30 degrees Celsius to 100 degrees Celsius. However, as stated above, Kuroda et al disclose a composition comprising an alicyclic component having a softening temperature of not lower than 110 degrees Celsius, and a 60% by weight crystalline polypropylene – olefin random copolymer mainly comprising polypropylene as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select an alicyclic component having a softening temperature of not lower than 110 degrees Celsius, but which is different from the alicyclic component disclosed by Kuroda et al, to provide a desired softening temperature of the composition and therefore peaks of loss tangent measured at a frequency of 1 hertz and a strain of 0.1% in the range from 30 degrees Celsius to 100 degrees Celsius, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Applicant also argues, on page 15, that Kuroda et al disclose an opaque film, whereas the claimed film is transparent. However, the transparency of the film is not claimed.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (571) 272 - 1497. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571) 272 - 1498. FAX communications should be sent to (703) 872-9306. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

Marc A. Patterson
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Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
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3/8/04